

REMARKS

Applicant has carefully reviewed the Office Action dated December 7, 2005. Applicant has amended Claims 1 and 12 to more clearly point out the present inventive concept. Reconsideration and favorable action is respectfully requested.

The specification stands objected to as failing to provide proper antecedent basis for the claimed subject matter. The Examiner specifically refers to claim 22. The Examiner has indicated that the term “means for transferring said extracted encoded information from said MRC” is not present and requires correction, however, Applicant believes that the Examiner is referring to claim 12, as that is where the language occurs. This objection is respectfully traversed.

With reference to the specification on page 45, and referring to Figure 25, this particular operation is specifically discussed. The claim requires that there be a means for “transferring” from “said extraction device” information in the form of “said extracted encoded information from said MRC” and “said unique identification information,” and transfer it to “said retail processing system” after the extraction of said encoded information from said MRC by said extraction device. This particular language requires the function of transferring, which result is to transfer from one place to another. Applicant believes that the structure of this claim is clearly relating to a device that is operable to transfer information such as the extracted encoded information from the device which extracts it, the extraction device, to a destination, that being the retail processing system. Therefore, the functionality of transferring is set forth and there is further required that this transferring step be performed after the step of extracting the encoded information from the MRC. In the specification, the flowchart of Figure 27 illustrates the basic process from an overall standpoint. The “means for transferring” is operable to transfer to a retail processing system both extracted encoded information and unique identification information. The extracted encoded information is that associated with the MRC, and the unique identification information is basically the scanner ID. The unique identification information is indicated as being associated with the user by the identification device. This association is then, through the use of the identification device, associated with the extraction operation of the extraction device. This is

AMENDMENT AND RESPONSE

S/N 09/597,131

Atty. Dkt. No. PHL Y-25,357

set forth at page 50, beginning at line 6 as follows:

Additionally, the portable scanner 2500 has associated therewith a unique scanner ID which is also then associated with the user (via the user ID) during this purchasing transaction.

Figure 28 provides the operation from the perspective of the POS. The basic operation associated with the “means for transferring” is set forth on page 46, beginning at line 5:

When the user has completed the selection process, the user then transmits the MRC data 2504 of the purchased articles of commerce 2502 by pressing a transmit button 2506 located on the portable scanner 2500. The transmitted data is received by a receiver 2508 connected to a PC (or POS - Point of Sale) system 2510. The scanner ID is then extracted from the transmitter data and used to retrieve the associated user ID from a local database 2512 (a database at some other location). Both the MRC data and the user ID are then assembled into a message packet and transmitted (in accordance with appended routing information which indicates the network address of the destination server) through a network interface 2514 across the GCN 306 through an account reference server (ARS) 2516.

It can thus be seen that the unique information, the scanner ID, and the information associated with the MRC, the MRC data, are both transmitted to the retail processing system. In this system, there is an intermediate node that is operable to extract the scanner ID and determine the user ID associated therewith for subsequent use. Thus, the overall retail processing system is operable to receive the scanner ID and MRC data and then complete the transaction thereafter. This is further illustrated with reference to the flow chart in Figure 28 beginning on page 51 at line 22 as follows:

If data has been received, flow is out the “Y” path of decision block 2808 to a function block 2810 where the PC/POS 2510 extracts the scanner ID data. Flow is then to a function block 2812 where the scanner ID is used in a matching operation on the PC/POS database 2512 to obtain the associated user ID.

In view of the above, Applicant believes that it is clear that there is the support for the operation of transferring this information, i.e., the extracted encoded information and the unique identification information to the retail processing system. As such, Applicant respectfully requests the withdrawal of the objection to the claimed subject matter, again assuming that the Examiner was referring to claim 12.

AMENDMENT AND RESPONSE

S/N 09/597,131

Atty. Dkt. No. PHL Y-25,357

Claims 1-11 stand rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner has noted that the claims are “replete with errors.” This rejection is respectfully traversed with respect to the amended claims.

The Examiner has indicated in item (a) of the rejection on page 3 the following:

Claim 1 recites the limitation of “the step of extracting unique identification information associated with the user” in lines 8 and 9. There is insufficient antecedent basis for this limitation in the claim.

The claim has been amended to change the terminology “associating unique information” to “associating the unique identification information.” This is believed to cure any confusion with respect to this portion of the claim.

The Examiner has a comment in paragraph “b” indicating the following:

Also in claim 1, it is unclear if “the step of extracting” in “after the step of extracting” as recited in line 10 is referring to “extracting the encoded information from the MRC” as recited in line 5 or alternatively, “the step of extracting unique identification information associated with the user” as recited in lines 8 and 9.

Applicant has amended the claim to indicate that this step of extracting is that associated with extraction via the extraction device and the language in claims 8 and 9 has been amended to indicate that the association step is that of associating the unique identification information with the step of extracting. Applicant has placed appropriate commas to clarify this language. As such, Applicant believes that the amendments to Claim 1 clarify this aspect.

The Examiner has indicated that claims 12-22 are indefinite with the following statement:

Claims 12-22 are indefinite because Applicant has not clearly linked and associated any corresponding structure with the claimed “means for transferring said extracted encoded information from said MRC”

AMENDMENT AND RESPONSE

S/N 09/597,131

Atty. Dkt. No. PHL-25,357

The Applicant believes that the above discussion with respect to the objection to the claims as failing to provide a proper intercedent basis is relevant to this rejection and refers to that discussion. As such, Applicant believes that claims 12-22 are clear.

The Examiner has indicated in claims 1-12 that it is unclear when the step of transferring ownership of the article of commerce takes place. The Examiner indicated that, in prior arguments, there is a suggestion that the transfer of ownership takes place upon the actual scanning of the article. Applicant believes that this is incorrect. Both claims 1 and 12 indicate that the operation of transferring ownership of the article of commerce is done to complete the transaction after, or in response to 1) the step of extracting, 2) the step of transferring from the extraction device, and 3) receiving from the extraction step at the retail processing system both the encoded information and the unique identification information. All three of these operations must be present in order to transfer ownership of the article of commerce to the user to complete the transaction according to the claim. Although there may be other steps such as verifying a credit card and the such, at least these three steps are required. The Examiner has only focused on one of these, and that was the actual scanning of the article. However, the claims clearly indicate that there are three steps that are required in order to transfer ownership of the article of commerce. As such, Applicant believes that claims 1 and 12 are not indefinite.

In view of the above arguments. Applicant respectfully requests withdrawal of the 35 U.S.C. §112 rejection with respect to claims 1-11 and 12-22.

Claims 12-22 stand rejected under 35 U.S.C. §102 (c) as being anticipated by *Ogasawara*. This rejection is respectfully traversed with respect to the amended claims.

In the Response to Arguments section on page 8 of the Office Action and paragraph 26, the Examiner has stated as follows:

With respect to *Ogasawara*, Applicant argues that “the Examiner did not

AMENDMENT AND RESPONSE

S/N 09/597,131

Atty. Dkt. No. PHL-25,357

specifically point to any specific language in *Ogasawara* for the payment provision in response to the information transferred ‘from the extraction device’ to the POS. . . . *Ogasawara* is nothing more than a portable scanner that is utilized to keep a history of lists and location information” the Examiner respectfully disagrees. First, in *Ogasawara*, the items are clearly purchased. See *Ogasawara* C16, L12-17, where the system tracks which items on the list are actually purchased. In order to do this, the system must keep track of purchased items. Additionally, *Ogasawara* directly discloses sending the items that the user desires to purchase to the POS system. See *Ogasawara* for example, C16, L37-39.

The Examiner has indicated first that, in *Ogasawara*, items are clearly purchased. Of course, Applicant does not indicate that there is not some indication that there is a purchased product at some point in time in *Ogasawara*. However, the Examiner refers to the portion of *Ogasawara* at column 16, lines 12-17. This portion of the specification is set out as follows:

An additional feature provided by the mobile terminal in accordance with practice of the invention is that the mobile terminal is able to keep track of which items on a customer provided shopping list were actually purchased, by comparing items scanned by the customer to items on the shopping list.

This portion of the specification merely indicates that the mobile terminal is “able to keep track of” items on a customer’s shopping list that were actually purchased. The reason for this is not to display this information to the user or for use by the user but, rather, for use by the store’s management personnel for the purpose of determining the store’s “opportunity loss” at a later time. (See column 16, lines 21-24.)

The Examiner also refers to the disclosure of *Ogasawara* at Col. 16, lines 37-39. This portion is set forth as follows:

For example, the personal shopping system may, which a customer scans an item, also transmit customer information to a point-of-sale (POS) terminal or to a mobile terminal utilized by store clerks.

This portion merely refers to the fact that, when a user scans a code, it can be transmitted to the POS. This is not for the purpose of purchasing but, rather, merely to identify the user and not the product. In fact, there is no mention of the product but, rather, the scanning operation is merely for identifying the

AMENDMENT AND RESPONSE

S/N 09/597,131

Atty. Dkt. No. PHLI-25,357

individual such that the store personnel can greet customers by name and significantly enhance personalization of the services rendered by the store. This certainly does not disclose or even suggest utilizing the scanning operation for the purpose of completing a purchase. As such, Applicant believes that the Examiner's response to Applicant's arguments are not supported by the specification of *Ogasawara* and, as indicated in previous responses, does not show that the use of the system is utilized for completing a transaction. Applicant believes that this device is merely utilized to keep track of the activity of a particular purchase in a store location. This is very common in today's retail stores in that user buying habits are very important to a particular store. They provide incentives in the form of discounts for utilizing a store card, such as a "Reward" card as provided by one well known store. These have no purpose other than to collect data for the store's purposes. To utilize it to complete a transaction is not the purpose of such cards and, Applicant believes that this is also not the purpose of the *Ogasawara* mobile terminal. Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. §102 rejection of claims 12-22 in view of *Ogasawara*.

Claims 1-11 stand rejected under 35 U.S.C. §102 (e) as being anticipated by *Ogasawara*. Applicant believes that the arguments made herein above with respect to claims 12-22 are equally applicable to claims 1-11 and, therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. §102 (e) rejection with respect to claims 1-11.

Claims 1-12 stand rejected under 35 U.S.C. §103 (a) as being patentable over *Ogasawara* in view of *Swartz et al.* The Examiner has indicated that the methods of purchasing are inherent in *Ogasawara* since *Ogasawara* directly discloses tracking purchases, referring again to column 16, lines 11-19 in sending the article of commerce information to a POS device after scanning, referring to column 7, lines 36-39. These were described herein above. Again, Applicant believes that this is not inherent, as the disclosure does nothing more than to indicate that a history of purchases is maintained within the portable terminal device. There is no indication that this portable terminal device enables or in any way facilitates the purchase other than by providing a record or list of MRC data associated with items that are desired to be purchased. In fact, the shopping list can be fully disposed within the portable terminal device and then purchases not made. However, the disclosure is silent on to any

AMENDMENT AND RESPONSE

S/N 09/597,131

Atty. Dkt. No. PHL-25,357

information directly disclosed or suggested of utilizing the portable terminal device to facilitate the instructions by the steps set forth in this claims. As such, Applicant believes that there is no inherency of this operation.

The Examiner indicates in the alternative, even if it is not inherent, then it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify *Ogasawara* as taught by *Swartz* to include more detail on how to purchase the item. The *Swartz* reference relates to a portable communication device that is operable to collect information about desired items to be purchased. However, the purchase operation is not in response to any scanning or transmission of a user ID for a retail processing system; rather, the embodiment of Figure 8 illustrates that the portable terminal is used merely to download data to a computer and then the computer is manually manipulated by the cashier. This is described beginning in column 10, line 46, wherein it states that the customer first has to provide his portable communication terminal ID to a cashier. The cashier then enters this ID into a register and transmits it to a store computer. The store computer then returns certain types of information such as a prompt to the cashier to request ID for alcoholic beverage purchases. There is also provided an off-line security check and, after that, the total purchase price is calculated and coupons are entered and the transaction is finished by a final bill being calculated and provided to the user from the cashier, at which time the user will tender cash, credit card or a check. Thus, there can be no initiation of a commercial transaction by the step of extracting the encoded information, since the extraction step is merely a collection of data by the user at the mobile terminal. Until a user goes up to the cash register, there is no initiation of a commercial transaction. As such, *Swartz* fails to disclose such a step. Further, the transfer of ownership of the article of commerce is not done in response to the step of extracting, the step of transferring, and the step of receiving. As such, Applicant believes that *Swartz* does not cure the deficiencies that were described herein above with respect to *Ogasawara*. Therefore, Applicant respectfully request withdrawal of the 35 U.S.C. §103(a) rejection with respect to claims 1-12 in view of *Ogasawara* and *Swartz et al.*

Claims 12-22 stand rejected under 35 U.S.C. §103 (a) as being unpatentable over a combination of *Ogasawara* and *Swartz*. However, Applicant believes that the Examiner erroneously referred to

AMENDMENT AND RESPONSE

S/N 09/597,131

Atty. Dkt. No. PHL-25,357

claims 1-12 in the prior rejection and meant to only reject claims 1-11. In any event, this rejection is respectfully traversed.

For the reasons described herein above, Applicant believes that claims 12-22 are not obviated by this combination as the addition of *Swartz* does not overcome the deficiencies of *Ogasawara*. Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103 (a) rejection with respect to claims 12-22.

Claims 1-12 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over the combination of *Ogasawara* in view of *Petrovich*. This rejection is respectfully traversed with respect to the amended claims.

The Examiner has repeated the inherency arguments herein above and these will not be further commented on, as the above comments are applicable herein.

The Examiner has indicated that, if inherency is not present, it would have been obvious to anyone having ordinary skill in the art at the time the invention was made to modify *Ogasawara* as taught by *Petrovich* to include more detail on how to purchase the item. The Examiner indicated that *Petrovich* directly discloses how a portable scanning terminal is used to purchase articles of commerce. The *Petrovich* reference is a reference that is directed toward a method for placing an order for items. This includes basically the use of a portable terminal to collect barcodes for use in a later transaction. Once these barcodes are collected, the user then disposes the portable terminal into a cradle for transfer of the data (bar codes) to a central system. This central system, or host computer, recognizes the user from identifying data received from the portable terminal. In general, this system is nothing more than a terminal that allows one to create a shopping list and utilize a shopping list to assist the user in picking up items and filling that shopping list. However, the actual purchase of the products does not rely upon the portable terminal. This is described beginning at column 12, line 49, as follows:

AMENDMENT AND RESPONSE

S/N 09/597,131

Atty. Dkt. No. PHL-25,357

Once the user has finished picking up the items they wished in shopping establishment **14**, they can be “checked out” at one of the point of sale check out terminals **56** in a manner similar to current computer-aided shopping systems. That is, they can present the computerized list and simply tender payment, with occasional auditing to ensure integrity of the system. The shopping list can be up-loaded to terminal **56** and printed.

The present invention can also be employed by store personnel who are picking a home-placed order which is already in the database of host computer **16**. An appropriate billing transaction can then be completed at any point in time by an y associate in the shopping establishment **14**, whether it be when the user comes to pick up the order, or before or after the order is shipped to the user.

It can be seen that this is nothing more than a conventional purchasing operation. As such, Applicant believes that the *Petrovich* reference does not cure the deficiencies noted herein above with respect to the combination of *Swartz and Ogasawara* or *Ogasawara* by itself. Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. § 103 rejection with respect to claims 1-12 in view of *Ogasawara* and *Petrovich*.

Claims 12-22 (noting that the previous rejection should have been claims 1-11) stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over *Ogasawara* in view of *Petrovich*. For the reasons described herein above, Applicant believes that this rejection is substantially similar to the others associated with claims 1-12 (11). Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. §103 (a) with respect to claims 12-22.

Applicant has now made an earnest attempt in order to place this case in condition for allowance. For the reasons stated above, Applicant respectfully requests full allowance of the claims as amended. Please charge any additional fees or deficiencies in fees or credit any overpayment to Deposit Account No. 20-0780/PHLY-25,357 of HOWISON & ARNOTT, L.L.P.

AMENDMENT AND RESPONSE

S/N 09/597,131

Atty. Dkt. No. PHLY-25,357

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